

REMARKS

At the outset, Applicant thanks the Examiner for the thorough review and consideration of the subject application. The Non-Final Office Action dated March 9, 2004 has been received and its contents carefully reviewed.

In the Non-Final Office Action dated March 9, 2004, the Examiner rejected claims 25-28 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement; objected to the drawings as failing to show every feature specified in the claims; rejected claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Watney (U.S. Patent No. 5,930,398) taken with Shau (U.S. Patent No. 6,404,670) in view of Kobayashi et al. (U.S. Patent No. 4,859,871); rejected claims 2 and 3 under 35 U.S.C. § 103(a) as being unpatentable over Watney taken with Shau in view of Kobayashi et al. as applied to claim 1 and further in view of Ng et al. (U.S. Patent No. 5,847,616); rejected claims 7 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Furuhashi et al. (U.S. Patent No. 5,850,540) taken with Smeets et al. (U.S. Patent No. 6,218,968) in view of Taguchi (U.S. Patent No. 5,815,080); rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Furuhashi et al. taken with Smeets et al. in view of Taguchi as applied to claim 7 and further in view of Kondo (U.S. Patent No. 6,222,398); objected to claims 4, 5, 9-13, and 15 as being dependent upon a rejected claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims; and allowed claims 29-33.

Applicant appreciates the allowance of claims 29-33 and the indication of allowable subject matter in claims 4, 5, 9-13, 15, 28, and 31-33. However, the rejections to the claims and objection to the drawings are traversed and reconsideration is respectfully requested in view of the following remarks.

The rejection of claims 25-28 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement, is respectfully traversed and reconsideration is requested.

In the instant rejection, the Examiner alleges that the claims “contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.” Specifically, the Examiner rejects claim 25 because it “makes reference to n voltage converters,” an element is allegedly “not addressed in the specification.”

Preliminarily, Applicant notes that the Examiner appears to apply form paragraph 7.31.02 in establishing a framework for the rejection above. However, in view of the substantive issues surrounding the rejection (i.e., that an element is not satisfactorily addressed in the specification), it appears as though the more relevant framework for the rejection is found within written description requirement of 35 U.S.C. § 112, first paragraph (see form paragraph 7.31.01). To meet the *prima facie* burden of any rejection under 35 U.S.C. § 112, first paragraph, for either lack of enablement or lack of written description, the Examiner must not only identify the problematic subject matter, but the Examiner must also provide an explanation supporting the rejection. (see M.P.E.P. §706.03(c)). Applicant respectfully submits that, by merely stating that “n voltage converters... is not addressed in the specification,” the Examiner has failed to establish a *prima facie* case of non-compliance with any of the requirements of 35 U.S.C. § 112, first paragraph.

Moreover, Applicant submits that the claimed “n voltage converters” are shown, for example, in Figure 8 and described, for example, at page 7, line 30 - page 8, line 24 of the instant application.

For at least the reasons presented above, Applicant requests withdrawal of the instant rejection under 35 U.S.C. § 112, first paragraph.

The objection to the drawings as failing to show every feature specified in the claims is respectfully traversed and reconsideration is requested.

The Examiner objects to the drawings because they “do not show the voltage converters taught in claim 25.” Applicant respectfully disagrees.

Specifically, Applicants submits that the claimed “voltage converters” are shown, for example, in Figure 8 of the instant application. Accordingly Applicant requests withdrawal of the instant objection to the drawings.

The rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Watney taken with Shau in view of Kobayashi et al. is respectfully traversed and reconsideration is requested.

Shau (U.S. Patent No. 6,404,670) is a Continuation-in-Part of Application No. 08/805,290, filed on February 25, 1997 (now U.S. Patent No. 5,825,704). A copy of U.S. Patent No. 5,825,704 is provided in the IDS submitted herewith. Applicant respectfully submits that the subject matter relied upon by the Examiner in Shau (U.S. Patent No. 6,404,670) is not

supported in U.S. Patent No. 5,825,704. Accordingly, Applicant respectfully submits the subject matter currently relied upon in Shau (U.S. Patent No. 6,404,670) has an effective filing date January 26, 2001. The present application is a Divisional of Application No. 09/170,526, filed on October 13, 1998. Accordingly, Applicant respectfully submits the subject matter relied upon in Shau (U.S. Patent No. 6,404,670) does not antedate the effective filing date of the subject matter currently claimed. For at least this reason, Applicant respectfully requests withdrawal of the instant rejection under 35 U.S.C. § 103(a).

According to M.P.E.P. § 707.07(f), in order to provide a complete application file history and to enhance the clarity of the prosecution history record, an Examiner must provide clear explanations of all actions taken during prosecution of an application. Where the Applicant traverses any rejection, the Examiner should, if they repeat the rejection, take note of the Applicant's argument and answer the substance of it. Applicant respectfully submits, while the argument presented immediately above was presented in the Submission under 37 C.F.R. § 1.114 filed on January 20, 2004, the Examiner failed to take note of the argument above, let alone answer the substance of it. Applicant respectfully submits that maintaining the instant rejection without acknowledging each and every argument frustrates the entire purpose of providing a complete application file history and of enhancing the clarity of the prosecution history record. Accordingly, if the Examiner intends to maintain the present rejection, Applicant respectfully requests that the Examiner answer the substance of each and every traversal set forth by Applicant in accordance with M.P.E.P. § 707.07(f).

The rejection of claims 2 and 3 under 35 U.S.C § 103(a) as being unpatentable over Watney taken with Shau in view of Kobayshi et al. and further in view of Ng et al. is respectfully traversed and reconsideration is requested.

Claims 2 and 3 include all of the elements of claim 1, as discussed above, and the combination of Watney taken with Shau in view of Kobayshi et al. fails to teach or suggest at least the features of independent claim 1 as recited above. Similarly, Ng et al. fails to cure the deficiencies of Watney taken with Shau in view of Kobayshi et al. Accordingly, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness regarding claims 2 and 3 in view of claim 1, as above. For at least this reason, Applicant respectfully requests withdrawal of the instant rejection under 35 U.S.C. § 103(a).

The rejection of claims 7 and 14 under 35 U.S.C § 103(a) as being unpatentable over Furuhashi et al. taken with Smeets et al. in view of Taguchi is respectfully traversed and reconsideration is requested.

Claim 7 is allowable over Furuhashi et al. taken with Smeets et al. in view of Taguchi in that claim 7 recites a combination of elements including, for example “receiving means for receiving an analog signal formed by compressing at least n-bit data, wherein n is an integer; quantizing means for quantizing the analog signal from the receiving means; and coding means connected to the quantizing means for coding the quantized analog signal to reconstruct the n-bit data.” Neither Furuhashi et al., Smeets et al., nor Taguchi, singly or in combination, teach or suggest at least these features of the claimed invention. Accordingly, Applicant respectfully submits that claims 8-15, which depend from claim 7, are also allowable over the cited references.

In rejecting claim 7, the Examiner cites Furuhashi et al. as teaching “receiving means for receiving an analog signal formed by compressing at least n-bit data, wherein n is an integer (col. 2, lines 46-54 and col. 3, lines 9-18 and 41-56)” but as failing to teach “quantizing means for quantizing the analog signal from the receiving means; and coding means connected to the quantizing means for coding the quantized analog signal to reconstruct the n-bit data; or a plurality of level detectors parallely connected to the input line to output a quantized signal.” Attempting to cure the deficiency of Furuhashi et al., the Examiner cites Smeets et al. as allegedly teaching “quantizing means for quantizing the analog signal from the receiving means; and coding means connected to the quantizing means for coding the quantized analog signal to reconstruct the n-bit data (col. 12, line 41-44).” The Examiner finally concludes it would have been obvious to “incorporate in the devices of Furuhashi et al. the feature as taught by Smeets et al... to put in place the means necessary to decompress compressed data and reconstruct the signal being processed for presentation to a display device.”

Applicant respectfully submits, however, that one of ordinary skill in the art would not be motivated to combine the teachings of Furuhashi et al. with Smeets et al. to “put in place the means necessary to decompress compressed data and reconstruct the signal being processed for presentation to a display device.” Specifically, at column 2, lines 31-35, Furuhashi et al. states “The CPU 11 supplies the compressed image data from the main memory 12 to the image expander which is coupled ...to a local frame memory 21 which the expander 14 uses to expand

the compressed image data and store the expanded image data,” at column 2, lines 46-48, Furuhashi et al. states “The expanded image data are read out from the local frame memory 21 to a D/A converter 22 for conversion to analog form,” and at column 2, lines 52-55, Furuhashi et al. states “The multiplexer 23 selects one of the analog signals received ...for output to an image monitor 25 in order to produce a composite image.”

In view of the above, Applicant respectfully submits that Furuhashi et al. inherently discloses means necessary for decompressing compressed data and for reconstructing signals suitable for presentation to a display. Given that Furuhashi et al., without modification, already accomplishes what the combination of Furuhashi et al. in view of Smeets et al. would allegedly accomplish, Applicant respectfully submits no motivation exists to combine Furuhashi et al. and Smeets et al. and arrive at the presently claimed invention. Applicant respectfully submits that such combination is suggested only by the claimed invention and combining the aforementioned references as described above would necessitate considerable impermissible hindsight. For at least this reason, Applicant respectfully requests withdrawal of the instant rejection under 35 U.S.C. § 103(a).

The rejection of claim 8 under 35 U.S.C § 103(a) as being unpatentable over Furuhashi et al. taken with Smeets et al. in view of Taguchi and further in view of Kondo is respectfully traversed and reconsideration is requested.

Kondo was filed on November 22, 1999. It is respectfully submitted, however, that the present application is a Divisional of Application No. 09/170,526, filed on October 13, 1998. Accordingly, Applicant respectfully submits that Kondo is not available as prior art with respect to the present application.

If the Examiner deems that a telephone conversation would further the prosecution of this application, the Examiner is invited to call the undersigned at (202) 496-7500.

Application No.: 09/982,829

Docket No.: 8733.080.10-US

Amendment dated July 8, 2004

Reply to non-final Office Action dated March 9, 2004

If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time, or any other fees required to complete the filing of this response, may be charged to Deposit Account No. 50-0911. Please credit any overpayment to deposit Account No. 50-0911. A duplicate copy of this sheet is enclosed.

Dated: July 8, 2004

Respectfully submitted,

By 
Kurt M. Eaton

Registration No.: 51,640
MCKENNA LONG & ALDRIDGE LLP
1900 K Street, N.W.
Washington, DC 20006
(202) 496-7500
Attorney for Applicant